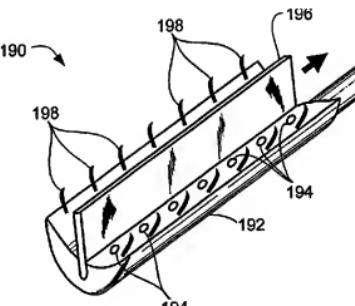


REMARKS

This Preliminary Amendment and Request for Continuing Examination Application is responsive to the Office Action dated July 10, 2008, and the Advisory Action dated September 19, 2008. In the Rule 1.116 Amendment dated August 22, 2008, Applicant argued the impropriety of the proposed combination of Deem, U.S. Patent No. 6,558,400, with Schurr, et al., U.S. Patent Publication No. 2002/0082621. Specifically, the Applicant argued that the Office Action had failed to explain how the Deem stapling device could be modified as suggested by the Office Action, and still operate as a stapling device. Because the staples are loaded in a compartment across the two tissue acquisition members, neither tissue acquisition members could pivot or move since the rigid staples would prevent such movement.

Referring to Figure 10 of Deem shown right, staples 198 shown in the Figures would prevent the device from being modified as suggested by the Office Action. Schurr, on the other hand, shows a drawbridge mechanism that captures a folded stomach tissue in a pinching manner. Even if Schurr suggested to one of ordinary skill in the art that Deem could be modified to include pivotable tissue acquisition members, the combination teaches a modification of Deem where the tissue acquisition member pivots back and forth like a drawbridge onto itself, not about the longitudinal axis as claimed. Neither of the references suggest a first and second tissue acquisition member that is pivotable along a longitudinal access of the device.



The Office Action contends that "it is not unreasonable to pursue the option of having at least one of the opposing acquisition members be pivotable in Deem, since it

would lead to anticipated success, which is likely the product not of innovation but ordinary skill and common sense." Applicant respectfully submits that the Office Action is ignoring the teachings of the actual references, while using the Applicant's teachings against the present application. The fact that the Advisory Action appears to concede that Deem could not be modified as the Office Action suggests is evidence that the two references, taken outside of the Applicant's disclosure, fails to teach the claimed invention.

The Advisory Action contends that the two references "suggested" the claimed invention to one of ordinary skill in the art. This can only be attributed to hindsight based on the Applicant's teachings, because there is nothing in the record that would compel one of ordinary skill in the art to take a drawbridge device that relies on pinching tissue and an immobile device that relies on suction, and come up with a mechanism that uses suction and rotates in a completely different fashion from the drawbridge mechanism. Further, Applicant respectfully submits that there is nothing in the record that suggests that Deem would operate any better with pivoting halves. Since it is designed to draw in tissue with suction, pivoting halves would unnecessarily add to the complexity of the device with no apparent benefit. Thus, the proposed modification must be attributed to impermissible hindsight.

Moreover, the use of the staples in both the left and right halves of the Deem apparatus shown above strongly teach away from having pivotable halves since it would serve no purpose here. Conversely, the grasping arm of the Schurr apparatus uses the arcing motion to cause the stomach wall to fold. Unlike Deem, there is no vacuum used in the Schurr device. Accordingly, the two devices teach **alternate but separate** methodologies for creating a fold of tissue that do not suggest a combination of the two technologies. Because the Deem device cannot pivot as constituted, and re-engineering the Deem device to allow it to pivot would necessitate an entirely different stapling

system, the Office Action's contention that it would not be unreasonable to pursue this proposed combination finds no support in the record. Because the rejection unduly relies on the Applicant's teachings to formulate the proposed combination of Deem and Schurr, Applicant respectfully submits that a *prima facie* case of obviousness has not been established and that the claims must be reconsidered in light of what the prior art references **actually suggest** to one of ordinary skill in the art without the benefit of the Applicant's present teaching.

New claim 29 includes the feature of pivotable first and second tissue acquisition members along a longitudinal access, a feature that is not shown in either of the cited prior art references (Deem does not teach any pivoting, and Schurr teaches pivoting about an axis transverse to the longitudinal axis). New claim 29 also includes the feature of a first and second tissue receiving cavity **56, 58** in the tissue acquisition members which are also not found in the cited references. Applicant respectfully submits that the features are not suggested by the prior art as well, and that the claim patentably distinguishes over the cited prior art. Newly added dependent claims 30-34 depend from new claim 29 and are asserted to be in allowable condition for the reasons set forth above. Accordingly, Applicant respectfully submits that the application is now in condition for allowance.

If the Examiner believes that a telephone conference will further the prosecution of this case, the Examiner is kindly invited to contact the undersigned at the number below. The Commissioner is authorized to charge any deficiencies or fees in connection with this preliminary amendment to Deposit Account No. 06-2425.

Respectfully submitted,

FULWIDER PATTON LLP

Dated: November 5, 2008 By: Michael J. Moffatt/
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